

**REMARKS**

This Amendment responds to the office action dated June 22, 2005.

The examiner has rejected claims 1-12 and 14-16 under 35 U.S.C. §103(a) as being unpatentable over Snipp (U.S. 5,699,495) (hereinafter Snipp) in view of Costello (U.S. 5,547,178) (hereinafter Costello). However, this rejection is improper because it fails to present a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, there must be more than the demonstrated existence of all of the components of the claimed subject matter. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the substitutions required. That knowledge cannot come from the applicants' disclosure of the invention itself.

Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678-79, 7 USPQ2d 1315, 1318 (Fed. Cir. 1988); In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). A proper obviousness rejection includes a recitation of a combination of references that disclose every element of the rejected claim along with a teaching or motivation, in at least one of the references, to combine the references.

The combination of Snipp and Costello does not disclose the elements of combining a print job separator page with a print job, and creating a combined print job comprising the original print job and a print job separator page. Costello teaches a method of automatically generating a banner sheet whenever a mailbox unit requires splitting a job in a location other than where it was expected. (col. 13, lines 36-47) The

banner sheet taught in Costello is a separate and distinct print job and is not combined with the original print job to create a new combined single print job as taught in the present invention. Neither Costello nor Snipp teach any form of combined print job that comprises a job separator page. Because this element is not disclosed in Snipp or Costello, claim 1 is allowable in its current form and the applicant respectfully requests that the examiner withdraw this rejection.

Regarding claims 2-12 and 14-16, each of these claims is dependent on claim 1 and is, therefore, patentable for the reasons stated above.

Claim 13 is rejected under 35 U.S.C. §102(b) as being anticipated by Snipp (U.S. 5,699,495) (hereinafter Snipp). However, this rejection fails to present a *prima facie* case of anticipation.

The embodiments of the present invention described in this rejected claims and the invention disclosed by Snipp are very different in function. Regarding claim 13 Snipp discloses a method for using DerMode structures which provide information about the form to be used when the document is printed to the device. (col. 6, lines 4-20) Snipp does not disclose a method for modifying the original print job to add a description of the print job characteristics to the original print job. The print jobs disclosed in Snipp are converted to different languages and rendered using typical printing methods, but they are not modified to include additional element such as the characteristic description of claim 13. Since Snipp does not disclose a method for modifying the original print job

Appl. No. 09/683,162  
Amdt. dated September 22, 2005  
Reply to Office action of June 22, 2005

to add a description of the print job characteristics to the original print job, claim 13 is allowable in its current form and the applicant respectfully requests that the examiner withdraw this rejection.

Based on the foregoing remarks, the Applicant respectfully requests reconsideration and allowance of the present application.

Respectfully submitted,

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